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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/072,382	02/06/2002	James D. Pravetz	07844-494001	2559

21876 7590 01/26/2005	EXAMINER
FISH & RICHARDSON P.C. 3300 DAIN RAUSCHER PLAZA MINNEAPOLIS, MN 55402	SCHLAIFER, JONATHAN D

ART UNIT	PAPER NUMBER
2178	

DATE MAILED: 01/26/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO 90C (Rev 10/03)

Office Action Summary	Application No.	Applicant(s)
	10/072,382	PRAVETZ, JAMES D.
	Examiner	Art Unit
	Jonathan D. Schlaifer	2178

-- Th MAILING DATE of this communication appears on th cover sheet with th correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>06 February 2002</u>.

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>1-32</u> is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) <u>1-32</u> is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on <u>06 February 2002</u> is/are: a)☒ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All   b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date <u>9/23/02</u>.

4)☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.

5)☐ Notice of Informal Patent Application (PTO-152)

6)☐ Other: _____.

DETAILED ACTION

1. This action is responsive to communications: Application 10/072,382, filed on 2/6/2002.

Prior art was filed on 9/23/2002.

2. Claims 1-32 are pending in this case. Claims 1 and 17 are independent claims.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

3. **Claims 1-3, 8, 10, 17-19, 24, and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wang (USPN 5,917,913—filing date 12/4/1996), further in view of Lewis et al. (USPN 6,233,565 B1—filing date 2/13/1998).**

4. **Regarding independent claim 1,** Wang discloses a method for signing an electronic document (Wang approves transaction requests in the Abstracts, which are a type of electronic document), the method comprising: establishing an electronic signature appearance for an electronic signature (the format is established in col. 7, lines 5-10); determining a bounding region on the electronic document for the display of the electronic signature appearance (this is an inherent portion of displaying the signature in col. 10, line 65 —col. 11, line 15; and signing the electronic document with an electronic signature, the electronic signature associated with the electronic signature appearance (in col. 7, lines 1-20, the e-signature is completed and the format is pre-associated with it). Wang fails to disclose at the time of signing an electronic document, previewing the

electronic signature appearance in the bounding region. However, Lewis discloses a preview feature in col. 19, line 50—col. 20, line 10 which could obviously be generalized to previewing an electronic signature. It would have been obvious to one of ordinary skill in the art at the time of the invention to preview the electronic signature to ensure that its format is appropriate before signing a document with it.

5. **Regarding dependent claim 2,** Wang discloses configuring the electronic signature appearance at the time of signing the electronic document (the format of the electronic signature is arrived at as the electronic signature is configured in col. 7, lines 5-15).

6. **Regarding dependent claim 3,** Wang and Lewis fail to specifically disclose configuring the electronic signature appearance comprises interacting with a user signing the electronic document. However, it was notoriously well known in the art at the time of the invention that configuring a format often involves user interaction in order to ascertain the user's preferences regarding the format. It would have been obvious to one of ordinary skill in the art at the time of the invention to involve user interaction in configuring the format in order to ascertain the user's preferences regarding the format.

7. **Regarding dependent claim 8,** Wang discloses including in the electronic signature appearance textual elements automatically copied from a certificate of a user signing the electronic document (in col. 7, lines 10-15, data items are appended to the signature).

8. **Regarding dependent claim 10,** Wang and Lewis fail to specifically disclose establishing an electronic signature appearance comprises interacting with a user to create an electronic signature appearance. However, it was notoriously well known in the art at the time of the invention that establish a format often involves user interaction in order to

ascertain the user's preferences regarding the format. It would have been obvious to one

of ordinary skill in the art at the time of the invention to involve user interaction in

establishing the format in order to ascertain the user's preferences regarding the format.

9. **Regarding independent claim 17,** it is a computer program product that performs the

method of claim 1 and is rejected under similar rationale.

10. **Regarding dependent claim 18,** it is a computer program product that performs the

method of claim 2 and is rejected under similar rationale.

11. **Regarding dependent claim 19,** it is a computer program product that performs the

method of claim 3 and is rejected under similar rationale.

12. **Regarding dependent claim 24,** it is a computer program product that performs the

method of claim 8 and is rejected under similar rationale.

13. **Regarding dependent claim 26,** it is a computer program product that performs the

method of claim 10 and is rejected under similar rationale.

14. **Claims 4-7, 9, 11, 13, 20-23, 25, 27, and 29 are rejected under 35 U.S.C. 103(a) as**

being unpatentable over Wang further in view of Lewis, further in view of "User's

Guide: Microsoft Word", Microsoft Corporation, Version 6.0, 1993-1994,

hereinafter Microsoft Corporation.

15. **Regarding dependent claim 4,** Wang and Lewis fail to specifically disclose configuring

the electronic signature appearance comprises: receiving user input activating controls for

controlling textual and graphic elements included in the electronic signature appearance.

However, Microsoft Corporation on page 114 discloses user input activating controls for

controlling textual and graphic elements present in text format (there are graphic

elements as some fonts include graphic elements). As this is analogous art, it would have

been obvious to one of ordinary skill in the art at the time of the invention to use controls

for controlling textual and graphic elements present because it would have offered the

user greater control over the various elements present in the format.

16. **Regarding dependent claim 5,** Wang and Lewis fail to disclose that the controls

comprise one or more of checkboxes and buttons. However, Microsoft Corporation on

page 114 discloses a dialog using checkboxes and buttons. It would have been obvious to

one of ordinary skill in the art at the time of the invention to use checkboxes and buttons

as in Microsoft Corporation's dialog on page 114 because these are user-friendly controls

which facilitate the user interface.

17. **Regarding dependent claim 6,** Wang and Lewis fail to disclose that previewing the

electronic signature appearance includes previewing a display in a configuration dialog

box of the electronic signature appearance within the bounding region and the controls

for controlling textual and graphic elements. However, Microsoft Corporation on page

114 discloses a region-bounded box which previews the format selected by the controls.

It would have been obvious to one of ordinary skill in the art at the time of the invention

to use Microsoft Corporation's preview within a bounding region in a dialog because this

is a user-friendly setup which provides flexibility and gives the user a great deal of

control over the format of the signature.

18. **Regarding dependent claim 7,** Wang and Lewis fail to disclose that previewing the

electronic signature appearance includes displaying the electronic signature appearance

within the bounding region on a display of the electronic document. However, Microsoft

Corporation on page 114 discloses that the preview is in a bounded region. It would have been obvious to one of ordinary skill in the art at the time of the invention to use a bounded region to display the signature as in Microsoft Corporation in Wang and Lewis because this would be an aesthetically pleasing and space-efficient way to display the signature.

19. **Regarding dependent claim 9,** Wang and Lewis fail to disclose that establishing an electronic signature appearance comprises receiving user input selecting an electronic signature appearance from one or more existing electronic signature appearances. However, on page 212 of Microsoft Corporation, Microsoft Corporation sets forth a selection of appearances between multiple templates to provide a flexible choice of appearances. It would have been obvious to one of ordinary skill in the art at the time of the invention to select an electronic signature appearance from one or more existing electronic signature appearances to provide a flexible choice of appearances.

20. **Regarding dependent claim 11,** Wang and Lewis fail to disclose that establishing an electronic signature appearance comprises receiving an electronic signature appearance pre-configured by an author of the electronic document to be signed. However, on page 214 of Microsoft Corporation, Microsoft Corporation sets forth configuration of templates to provide a flexible choice of appearances. It would have been obvious to one of ordinary skill in the art at the time of the invention to select an electronic signature appearance from pre-configured templates to provide a flexible choice of appearances.

21. **Regarding dependent claim 13,** it reiterates limitations of claim 7 and is rejected under the same rationale.

22. **Regarding dependent claim 20,** it is a computer program product that performs the method of claim 4 and is rejected under similar rationale.

23. **Regarding dependent claim 21,** it is a computer program product that performs the method of claim 5 and is rejected under similar rationale.

24. **Regarding dependent claim 22,** it is a computer program product that performs the method of claim 6 and is rejected under similar rationale.

25. **Regarding dependent claim 23,** it is a computer program product that performs the method of claim 7 and is rejected under similar rationale.

26. **Regarding dependent claim 25,** it is a computer program product that performs the method of claim 9 and is rejected under similar rationale.

27. **Regarding dependent claim 27,** it is a computer program product that performs the method of claim 11 and is rejected under similar rationale.

28. **Regarding dependent claim 29,** it is a computer program product that performs the method of claim 13 and is rejected under similar rationale.

29. **Claims 12, 14, 28 and 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wang further in view of Lewis, further in view of Neff et al (USPN 6,751,780 B1—filing date 10/1/1998), hereinafter Neff.**

30. **Regarding dependent claim 12,** 12. Wang and Lewis fail to disclose that determining a bounding region on the electronic document for the electronic signature appearance comprises interacting with a user signing the electronic document to establish the bounding region. However, Neff discloses establishing a boundary using drag and drop in col. 5, lines 35-55. It would have been obvious to one of ordinary skill in the art at the

time of the invention to combine Neff with Wang and Lewis because drag and drop

would have enhanced their inventions because it is a user-friendly method for

establishing bounding regions.

31. **Regarding dependent claim 14,** Wang and Lewis fail to disclose determining the

bounding region on the electronic document for the electronic signature appearance

comprises establishing a bounding region pre-set by an author of the electronic

document. However, Neff discloses establishing a boundary using drag and drop in col.

5, lines 35-55. It would have been obvious to one of ordinary skill in the art at the time

of the invention to combine Neff with Wang and Lewis because drag and drop would

have enhanced their inventions because it is a user-friendly method for establishing

bounding regions. Further, it was notoriously well known in the art at the time of the

invention that interactions such as establishing a boundary may be done in advance to

save time at runtime. Therefore, it would have been obvious to one of ordinary skill in

the art at the time of the invention to use a pre-set bounding region in order to save time

at runtime.

32. **Regarding dependent claim 28,** it is a computer program product that performs the

method of claim 12 and is rejected under similar rationale.

33. **Regarding dependent claim 30,** it is a computer program product that performs the

method of claim 14 and is rejected under similar rationale.

34. **Claims 15-16 and 31-32 are rejected under 35 U.S.C. 103(a) as being unpatentable**

over Wang further in view of Lewis, further in view of Rubin (USPN 6,654,009 B2—

filing date 5/23/2001).

35. **Regarding dependent claim 15,** Wang and Lewis fail to disclose determining an optimal layout of the electronic signature appearance based on the dimensions of the bounding region. However, Rubin in col. 3, lines 15-40 discloses finding a layout which is optimized based on the bounding region. It would have been obvious to one of ordinary skill in the art at the time of the invention to find a layout which is optimized based on the bounding region because it would be visually appealing.

36. **Regarding dependent claim 16,** Wang and Lewis fail to disclose determining optimal dimensions of the bounding region based on the electronic signature appearance. However, Rubin, in the Abstract, lines 1-15, discloses optimizing region size based on format. It would have been obvious to one of ordinary skill in the art at the time of the invention to optimize region size based on format because it would provide an ideal method of arranging entities two-dimensionally that would reflect the requirements of the format, which would be visually appealing, (see col. 1, lines 25-30).

37. **Regarding dependent claim 31,** it is a computer program product that performs the method of claim 15 and is rejected under similar rationale.

38. **Regarding dependent claim 32,** it is a computer program product that performs the method of claim 16 and is rejected under similar rationale.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's

disclosure.

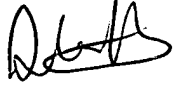USPN 5,724,423 (filing date 9/18/1995)—Khello

USPN 5,623,637 (filing date 5/17/1996)—Jones et al.

Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Jonathan D. Schlaifer whose telephone number is (571) 272-

4129. The examiner can normally be reached on 8:30-5:00, M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Stephen Hong can be reached on (571) 272-4124. The fax phone number for the

organization where this application or proceeding is assigned is 703-872-9306.

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JS

STEPHEN HONG
SUPERVISORY PATENT EXAMINER